

REMARKS / ARGUMENTS

Election / Restriction

The claims have been amended so that they are, it is believed, consistent with the elected invention as delineated by the action.

Claim Objections

The objection to claim 12 is believed overcome by the amendments made in claim 12. A comma and a carriage return have been inserted after (Z)-3-[1-(4-piperidinomethyl-phenylamino)-1-phenyl-methylidene]-5-methylsulphonylamino-2-indolinone, so that it is now clearly separated from (Z)-3-{1-[4-(piperidinomethyl)-phenylamino]-1-phenyl-methylidene}-5-ethylsulphonylamino-2-indolinone.

The objection to claim 13 is overcome by the amendment which renders claim 13 no longer dependent from claims 8-11.

As noted previously, the claims have been amended so that they no longer embrace non-elected subject matter. Such amendments should overcome the objection to claims 1-13 on the ground that they formerly contained non-elected subject matter.

Priority

An English translation of the non-English provisional application No. 60/251,055, together with a statement that the translation is accurate, as required by 37 CFR 1.78(a)(5) is provided herewith. Similarly, an English translation of the non-English foreign priority application DE100 54 019, together with a statement that the translation is accurate, as required by 37 CFR 1.55 is provided herewith. Accordingly, it is believed that the effective date of the application, for the purpose of overcoming prior art, should be November 1, 2000, the filing date of foreign priority application DE100 54 019.

Claim Rejections – 35 USC § 112

Claim 1 has been amended in the manner suggested by the Examiner, so that the word “or” no longer appears between the definitions of R₄ and R₅. This overcomes the first stated basis for rejection under Section 112, second paragraph.

Double Patenting

The provisional double patenting rejection over copending Application No. 10/646,495 will be overcome by the amendments which have been made in this application and the amendments which will be made in copending Application No. 10/646,495.

Non-Statutory Obviousness-Type Double Patenting

To overcome the provisional rejection of the claims on the basis of non-statutory obviousness-type double patenting, a terminal disclaimer is submitted herewith. This disclaims the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 6,794,395 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned.

Claim Rejections – 35 USC § 102 and 35 USC § 103

As noted previously, an English translation of the non-English provisional application No. 60/251,055, together with a statement that the translation is accurate, as required by 37 CFR 1.78(a)(5) is provided herewith. Similarly, an English translation of the non-English foreign priority application DE100 54 019, together with a statement that the translation is accurate, as required by 37 CFR 1.55 is provided herewith. Accordingly, it is believed that the effective date of the application, for the purpose of overcoming prior art, should be November 1, 2000, the filing date of foreign priority application DE100 54 019. It is believed that WO 01/16130 is thus removed as prior art and the rejections under 35 USC 102 and 35 USC 103 are overcome.

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